

REMARKS

This is in response to the office action dated June 18, 2008.

Applicant would like to thank the Examiner for his careful review of the application.

The specification has been amended to include the appropriate wording for incorporation by reference. English translations of the references DE 44 35 043 A1, DE 44 16 597 A1, and DE 196 are submitted herewith as NPL documents. Additionally, excerpts from the references have been inserted into the specification. The inserted material is the material previously incorporated by reference.

A substitute specification and a marked up application are being submitted herewith. Please enter the substitute specification. Please amend claim 45 to correct a typo. Replacement drawings are also being submitted herewith.

The statement required by 37 CFR 1.57 (e) and 37 CFR 1.57(f) are incorporated herein.. The application is now believed to be in a condition for allowance. No new matter has been added.

A response to each of the Examiner's assertions follows:

Upon evaluating the cited references the examiner made the following decisions:

In paragraph 3 of the office action the Examiner stated:

a) ... it is necessary to clearly recite the wording "incorporated by reference" in the specification, instead of as casual narratives among the text...

The specification has amended to recite the “incorporation by reference” language for each German patent cited in the specification and specific excerpts have been included in the specification from the German patent references.

b)... Applicant is required to replace the German document with their equivalent US patent (application) documents, or other NPL documents written in the English language.

English translations of the German documents are being submitted herewith.

c) The claims having been amended (per Preliminary Amendment dated 03/14/2006), the disclosure [sic] should no longer recite any reference to a cancelled claim....

The specification has been amended to include the incorporation by reference for each of the three German patent references. References to the claims in the specification has been cancelled. A substitute specification is being submitted herewith. A clean version and a marked-up version of the specification is submitted herewith.

In paragraph 5 of the office action the Examiner states:

**The disclosure is objected to because of the following informalities:
On page 3, line 12 from the bottom, it recites Claim 20. However, claim 20 has been cancelled per Preliminary Amendment dated 03/14/2006. Appropriate correction is required.**

The specification has been amended to obviate the reason for this rejection.

In paragraph 5 of the office action the Examiner states:

.....Applicant is required to amend the disclosure to include the material incorporated by reference... The amendment must be accompanied by a statement

executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter.

Applicant respectfully traverses this requirement as the specification is believed to fully comply with 35 U.S.C. Section 112, first and second paragraphs. However, the specification has been amended to obviate the reason for this rejection pursuant to the instructions of the Examiner.

In paragraph 7 of the office action the Examiner states:

The attempt to incorporate subject matter into this application by reference DE 44 35 043 A1, DE 44 16 597 A1, and DE 196 09 234, is ineffective because the references, which constitute “Essential Material” according to 37 CFR 1.57 (c), are not provided in the English language.

Applicant respectfully traverses this requirement as the specification is believed to fully comply with 35 U.S.C. Section 112, first and second paragraphs. However, the specification has been amended to obviate the reason for this rejection.

In paragraph 8 of the office action the Examiner states:

The incorporation by reference will not be effective until correction is made to comply with 1.57 (b), (c), or (d).

The specification has been amended to obviate the reason for this rejection. English translations of the references DE 44 35 043 A1, DE 44 16 597 A1, and DE 196 09 234 are submitted herewith as NPL documents. The specification has been amended to standard incorporation by reference. Additionally, the specification has been amended to include excerpts from the foreign references. A substitute specification is being

submitted herewith.

In paragraph 9 of the office action the Examiner states:

Claims 1-4 and 39-54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

Applicant respectfully traverses this requirement as the specification is believed to fully comply with 35 U.S.C. Section 112, first and second paragraphs. However, the specification has been amended to obviate the reason for this rejection. The specification has been amended to include the standard wording “incorporated by reference” and copies of the cited references are being included in the English language. The specification has been amended to include excerpts from the foreign references. A substitute specification is being submitted herewith.

In paragraph 10 of the office action the Examiner states:

Claims 1-4 and 39-54 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling.

Applicant respectfully traverses this requirement as the specification is believed to fully comply with 35 U.S.C. Section 112, first and second paragraphs. However, the specification has been amended to obviate the reason for this rejection. English translations of the three foreign references have been provided. The Examiner has acknowledged that the disclosure of these three references is enabling. Excerpts from the foreign references have been included in the specification. A substitute specification is being submitted herewith.

In paragraph 11 of the office action the Examiner states:

Claims 1-4 and 39-54 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites a process of particle-beam-induced deposition, which is not adequately known by a prospective user, since the references cited in the specification are all in the German language, thus effectively rendering the process indefinite. Consequently, claims 2-4 and 39-54 depending on claim 1 are all deemed indefinite .

Applicant respectfully traverses this requirement as the specification is believed to fully comply with 35 U.S.C. Section 112, first and second paragraphs. However, the specification has been amended to obviate the reason for this rejection. The references cited in the specification is now to German applications where a translation is being provided.

In paragraph 12 of the office action the Examiner stated:

Claims 1-4 and 39-54 are objected to as being rejected under USC 112/1 and 112/2, but would be allowable upon obviating the present rejection of the parent claim 1 by providing adequate incorporation by reference according to 37 CFR 1.57 (b), (c) and (d).

Applicant thank the Examiner for the determination of allowable subject matter.

The objection has been obviated by providing adequate incorporation by reference according to CFR 1.57 (b), (c) and (d). The specification has been amended to include the appropriate incorporation by reference wording and copies of the cited references are being included in the English language. The specification has been amended to include excerpts from the foreign references. A substitute specification is being submitted herewith.

Statement under 37 CFR 1.57 (e)

The copies of the three foreign references, to wit, DE 44 35 043 A1, DE 44 16 597 A1, and DE 196 09 234 , consists of the same material incorporated by reference in the referencing application.

Statement under 37 CFR 1.57 (f)

The material being inserted, to wit, excerpts of English translations of DE 44 35 043 A1, DE 44 16 597 A1, and DE 196 09 234, is the material previously incorporated by reference. The amended substitute specification contains no new matter.

Claims 1-4 and 39-54 are in the application and are believed allowable.
Reconsideration of the claims is respectfully requested.

The undersigned invites a telephone call from the Primary Examiner if it would expedite the processing and examination of the application.

Respectfully Submitted,

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